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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of:
John Eric Arnold
For: PART NUMBER
IDENTIFICATION TAG
Serial No.: 10/069,301
Filed: February 18, 2002

Confirmation No. 2013
Docket No. DN1999215USA
Art Unit: 3683
Examiner: Melanie Torres

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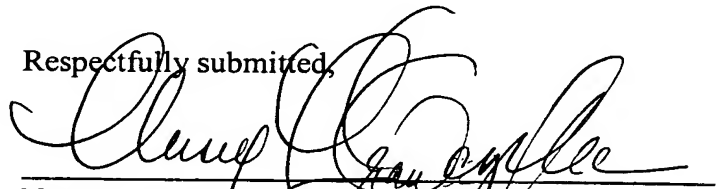
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APPEAL BRIEF

Filed herewith please find Applicants' Appeal Brief, filed in triplicate, pursuant to 37 C.F.R.

The Commissioner is hereby authorized to charge the fee of \$500 to Applicant's Deposit Account 07-1725. The Commissioner is also authorized to charge any additional filing fees which may be required or to refund any overpayment to account No. 07-1725.

Respectfully submitted,


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APPEAL BRIEF

Real Party in Interest

The real party in interest of the present application is The Goodyear Tire & Rubber Company.

Related Appeals and Interferences

There are no related appeals or interferences.

Status of Claims

Claims 1 to 10 are pending in the application. Claims 1 to 10 stand rejected.

Status of Amendments

There are no outstanding amendments. No amendments have been filed following the most recent rejection, the Final Rejection, dated November 16, 2004.

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Summary of the Invention

The present invention is directed to an airspring. The airspring 10 has a reinforced elastomeric sleeve 16. To form an airtight assembly comprising an internal chamber, the sleeve 16 is secured at both ends, with a retainer 14 securing a first end of the sleeve 16 (pg 2, lines 15-25). For identification of the airspring product, secured between the retainer 14 and the sleeve 16 is an identification tag 12 (Fig. 1; pg 2, lines 25-26). The tag 12 is secured to the airspring components at the same time as the retainer 14 is crimped onto the end of the sleeve 16 (pg 2, lines 27-34).

The tag 12 is formed from a single sheet-like material (Figs 1, 3). When secured to the airspring, the tag 12 has an upper end 34 having an S-shaped configuration corresponding to the crimped upper end of the sleeve 16 (Fig. 2; pg 3, lines 1-2) and an extending end 30 wherein the identifying indicia is provided. The extending end 30 may also has a curvature to correspond to the curvature of the air sleeve 16 (Fig 2; pg 3, lines 2-5). The different curved portions of the tag may be formed prior to securing the tag 12 to the air spring sleeve 16 (original claims 3 & 4) or occur due to the use of a flexible material.

The principal aspect of the present invention is that the tag (12) is secured the air spring components in a non-removable manner (pg 1, lines 34-35). By crimping the retainer about the sleeve end and the tag, the tag cannot be removed from the airspring but becomes a permanent part of the airspring. This tag replaces previously known and conventional airspring identification methods such as adhesive labels that may become unglued or otherwise damaged and printing directly on the airsleeve which may become scrapped off or worn away.

Issues

Are the claims obvious under 35 U.S.C. § 103(a) over Geno et al. In view of Robinson?

Grouping of Claims

Claims 1-10 are grouped together and stand or fall together.

Arguments

Claims 1-10 stand rejected under 35 U.S.C. § 103(a) as obvious over Geno et al. in view of Robinson.

A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains.

35 U.S.C. § 103(a)

Geno et al is cited as teaching an airspring comprising a flexibly cylindrical sleeve having a first and second end and a retainer secured to one of the ends of the sleeve. It is recognized that Geno et al does not teach a tag made of sheet material that is non-removably secured between the sleeve and the retainer (Office Action 11/16/2004). In fact, Geno provides no form of identification tagging for the air spring.

Robinson is cited as teaching a tag made from a sheet material with a portion of the tag being “non-removably secured between a sleeve (1) and a retainer (5).” Robinson, in fact, discloses a method of providing tags for can-like containers; Robinson being specifically concerned about paint cans with the tag providing information regarding the contents of the can (pg 1, lines 3-5). The tag is provided with a tongue or projection that is passed through a hole formed in the lid of the can-like container (pg 1, lines 13-18).

It has been held that it would have been obvious to one of skill in the art to have “had the tag of Hofe” [this presumably should have read ‘had the tag of Robinson’] on the air spring of Geno to provide identification for the manufactured part. Applicants disagree with this holding for the following reasons.

To establish *prima facie* obviousness, there 1) must be some suggestion or motivation in the art to modify or combine the references; 2) must be a reasonable

expectation of success and 3) the combined references must teach or suggest all the claim limitations.

First, there is no motivation in the art to modify Geno or combine the teachings of Robinson with Geno. It is stated in the Office Action that the reason to provide a tag would be to provide identification for the manufactured part. However, that reasoning is not taught by either Geno or Robinson; the argued motivation is not present in either reference. Geno is silent about any need to provide an external identification tag. Robinson teaches that the tag is to provide information about the contents of the can; for an air spring there is no such need – those skilled in the art know what is inside an airspring – air. The only motivation to provide Geno with a part identification tag is provided within Applicant's specification. To combine these references in the manner set forth in the Office Action is solely based upon hindsight provided by Applicant's own teachings. There is no motivation to combine these references other than to make the present rejection.

In response to this argument, in the Final Office Action of 11/16/2004, it is stated that motivation to combine or modify references may be found either in the references themselves "or in the knowledge generally available to one of ordinary skill in the art," relying upon *in re Fine* and *in re Jones*, and again simply repeats that it would have been obvious to put a tag on Geno for identification purposes. The Examiner never states it, but appears to be relying upon "knowledge generally available to one of ordinary skill in the art" for motivation to combine.

However, the court's position from *in re Jones* is not fully set forth in the above cited proposition. The court stated "It can satisfy this burden only by showing some objective teaching in the prior art or that knowledge generally available to one of ordinary skill in the art would *lead that individual to combine the relevant teachings of the references*", *id*, 5 USPQ2d at 1598 (emphasis added). Thus the court still supported the position that motivation must still come from the prior art. In fact, the court cited *ACS Hosp. Sys., Inc. v. Montefiore Hosp.*, 221 USPQ 929, 933 (Fed Cir 1984), that obviousness "cannot be established by combining the teachings of the prior art to produce the claimed invention, absent some teaching or suggestion supporting the combination" and "teachings of references can be combined *only* if there is some suggestion or incentive to do so." In *in re Fine*, the failure of the references to provide such motivation led the court to a holding of hindsight in the

formulation of the rejection, and a holding that a *prima face* case of obviousness was not met.

In *in re Jones*, the court again looked for evidence, other than speculation in the rejection, in the prior art for the rejection. That court stated “there must be adequate support in the prior art, in order to complete the PTO’s *prima facie* case and shift the burden of going forward to the applicant” *id*, 21 USPQ2d at 1944 (citing *in re Lalu*, 223 USPQ 1257, 1258 (Fed Cir 1984)).

Motivation in the prior art is essential requirement of the law to establish *prima facie* obviousness, not merely suggestive. Again, as noted above, there is no motivation in Geno to look to apply an identification tag to the airspring during manufacture of the airspring. Robinson teaches applying a tag for the purpose of identify the contents of the can. The sole motivation to use a tag of the type of Robinson in the airspring of Geno is provided by hindsight. The PTO has failed to meet their burden of *prima facie* obviousness.

Second, to modify the air spring of Geno in the manner as taught by Robinson, the retainer of Geno must be provided with a hole through which the tag must pass. Because the goal of an air spring is to have control over the airflow into and out of the air spring, to simply punch a hole into the retainer would potentially destroy the operability of the air spring. One of ordinary skill in the airspring art would not seek to place additional holes in the retainer, potentially destroying the sealed chamber. Additionally, Robinson teaches the use of an additional lip 4 over the can-like container that cooperates with the lid and the tag. The addition of a similar lip is not practical for the sleeve of an airspring, as the lip of Robinson requires the material of both the lip and the container to be a non-flexible material, which an air spring sleeve is not.

In response to this argument, in the Office Action of 11/16/2004, it is held that such arguments make presumptions about the teachings of Robinson, and there is no air gap between the components. No such assertion is being made by the Applicants. Applicants are stating that one skilled in the art would not seek to provide additional holes in a product meant to be airtight nor would they seek to use a lip 4 like that required by Robinson to effect sealing and mounting of the tag.

It is also stated that this argument is deemed more specific than the claim language. Presumably, this means that the argument that the airspring must be sealed

to form an airtight seal between the retainer and the sleeve is more specific than the claim language. Applicant disagrees. By mere definition of the product of an air spring, one skilled in the art is aware that an air tight seal must be achieved and maintained between the retainers and the sleeve in order to obtain the internal air chamber; air travels into and out of an airspring only through the air passage located in the retainer (see FIG. 1). To call this argument “more specific than the claim language” is akin to requiring a tire claim to recite the tire is round – it is an inherent, understood feature of the product.

Third, the present invention recites that the tag is non-removably secured to the airspring. Such is not the case with the paint can of Robinson. A paint can lid is often removed, and the tag may be readily removed from the slot in the lid. Thus, an essential element of the recited invention is not taught by the cited art.

Thus, the examiner has failed to establish *prima facie* obviousness as the rejection fails to meet all three of the requirements established by Graham v. Deere. It is respectfully requested that the rejection of the claims over Geno et al in view of Robinson be withdrawn.

A handwritten signature in black ink, appearing to read "Nancy T. Krawczyk", written over a horizontal line.

Nancy T. Krawczyk, Reg. No. 38,774
Attorney for Applicant



CLAIMS

1. An airspring comprising a flexible cylindrical sleeve having a first and second end, a retainer secured to one of the ends of the sleeve, and a tag made from a sheet material, the improvement comprising:
a portion of the sheet material forming the tag being non-removably secured between the sleeve and the retainer.
2. An airspring in accordance with claim 1 wherein the tag is of a flexible plastic or elastomeric material.
3. An airspring in accordance with claim 1 wherein the portion of the tag that is secured between the sleeve and the retainer, prior to being secured between the sleeve and the retainer, has a shaped configuration corresponding to the shaped configuration of the sleeve end.
4. An airspring in accordance claim 1 wherein the tag, prior to being secured between the sleeve and the retainer, has a molded circumferential curvature corresponding to the outer curvature of the cylindrical sleeve.
5. An arising in accordance with claim 1 wherein the tag is provided with indicia in a manner which will last the lifetime of the airspring.
6. An airspring in accordance with claim 5 wherein the indicia is presented in an alphanumeric manner or as a bar code.
7. An airspring in accordance with claim 5 wherein the indicia is formed by punching out the idicia from the tag, stamping the indicia onto the tag, or imprinting the indicia onto the tag.
8. An airspring in accordance with claim 1 wherein the color of the tag contrasts with the color of the airsleeve.

9. An airspring comprising a flexible cylindrical sleeve having a first and second end, a retainer secured to one of the ends of the sleeve and a tag made from a sheet material, a portion of the tag being non-removably secured between the sleeve and the retainer, wherein the portion of the tag that is secured, prior to being secured, has a shaped configuration corresponding to the shaped configuration of the sleeve end.
10. An airspring comprising a flexible cylindrical sleeve having a first and second end, a retainer secured to one of the ends of the sleeve and a tag made from a sheet material, a portion of the tag being non-removably secured between the sleeve and the retainer, wherein the tag, prior to being secured, has a molded circumferential curvature corresponding to the outer curvature of the cylindrical sleeve.